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Signature Theodore J. Leitereg Date 10/25/06
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PATENTS
Attorney Docket No. 10030679-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Francisco J. Cifuentes, *et al.*

Serial No. 10/718,342

Group Art Unit: 1631

Confirmation No.: 1237

Examiner: Ritesh Agrawal

Filed: November 20, 2003

Title: Methods for Analysis of Tissue Pair Combinations for Use in Nucleic Acid Array Technology

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Response to Restriction Requirement

This paper is responsive to the Restriction Requirement in the Office Action dated June 29, 2006, from the U.S. Patent and Trademark Office in the above-identified patent application.

Restriction was required under 35 U.S.C. §121 to one of the following inventions:

Group I – Claims 1-11 and 20-26, drawn to a method for selecting a combination of nucleic acid sample pairs, classified in class 436, subclass 63.

Group II – Claims 12-19 and 27-28, drawn to computer-based implementations, classified in class 702, subclass 19.

In making the Restriction Requirement, a determination was made that the inventions of Groups I and II are distinct each from the other. According to M.P.E.P. 802.01 the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for

its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, in making the restriction requirement the Office Action is acknowledging at least implicitly that the inventions of the aforementioned groups are separately patentable over one other. If this were not the case, then the restriction requirement would not be proper.

Furthermore, it follows from the above that art (if such art exists) that discloses no more than the subject matter of the claims of one of the above groups cannot render known or obvious the invention of the other group and vice versa. If this were not the case, then the restriction requirement with respect to those claims would not be proper.

Applicant recognizes that the M.P.E.P. does state, "though they may each be unpatentable because of the prior art." However, this language must only mean that there may be art that renders one of the inventions unpatentable and other art that renders another of the inventions unpatentable. The language cannot mean that art disclosing no more than the subject matter of the claims of one of the groups and anticipating or rendering obvious the invention of that group would also anticipate or render obvious the inventions of the other group. If so, then the inventions of the separate groups would not be patentable over one another and the restriction requirement would be improper.

In response to and as required by the Restriction Requirement, Applicant elects the invention of Group I, Claims 1-11 and 20-26. Applicant reserves the right to file divisional patent applications to the subject matter that the Office Action has determined to be patentably distinct and separately patentable.

Respectfully submitted,



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